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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/515,796	02/29/2000	Guido M. Schuster	99,599	1037

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EXAMINER

WEN, SHAOJUN

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 12/30/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/515,796

Applicant(s)

SCHUSTER ET AL.

Examiner

Shaojun Wen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 February 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-48, 66-70 and 73-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-48, 66-70 and 73-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-18, 49-65, 71-72 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 - 13
- 4) ☒ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. This action is responsive to application filed on February 29, 2000, with the above serial number, in which claims 1-75 are pending.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-18, 49-65, and 71-72, are drawn to proximity-based registration system, classified as class 709, subclass 227.
 - II. claims 19-48, 66-70, and 73-75 drawn to data network appliance, classified as class 709, subclass 208.
3. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because proximity-based registration system does not require particular audio input interface and voice-over data module. The subcombination has separate utility such as audio input interface and voice-over data module.

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4. Because these inventions are combination and subcombination for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Marcus Thymian on 10/29/2002 a provisional election was made with traverse to prosecute the invention of group II contains claims 19-48, 66-70, and 73-75. Affirmation for this election must be made by applicant in replying to this Office action. Claims 1-18, 49-65, and 71-72 are withdrawn from further consideration by the examiner, 37 CFR 1. 142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 19, 23-25, 28-34, 36-37, 40-48, 73-75 are rejected under 35 U.S.C. 102(e) as being anticipated by Gaucher (hereinafter “Gaucher”, USPN 6,175,860).

As per claim 19, Gaucher teaches a data network appliance, comprising in combination:

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a proximity receiver operable to detect an announcement message transmitted by a portable information device, wherein the proximity receiver is detached from the portable information device (col 7, line 48-57);

an audio input interface operable to receive an audio input signal from a user (col 3, line 32-43);

an audio output interface operable to transmit an audio output signal to the user (col 3, line 36-43);

a voice-over-data module operable to convert the audio input signal into a digital audio transmit stream, and wherein the voice-over-data module is operable to convert a digital audio receive stream into the audio output signal (col 3, line 36-43);

an interface to a data network, wherein the data network provides data connectivity for a plurality of data communications channels using data transport protocols, wherein at least one of the plurality of data communications channels is operable to support the digital transmit stream and the digital receive stream, and wherein the data network links the data network appliance to a registration server; and a registration module operable to transmit a registration request to the registration sever responsive to the proximity receiver detecting the announcement message (col 3, line 51-67).

As per claim 23, Gaucher teaches the data network appliance, wherein the audio input signals and audio output signals are voice signals (col 3, line 36-43).

As per claim 24, Gaucher teaches the data network appliance, wherein the voice-over-data module is an application executable by the processor (i.e. master computer) (col 3, line 36-50).

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As per claim 25, Gaucher teaches the data network appliance, further comprising a proximity transmitter (col 6, line 34-40).

As per claim 28, Gaucher teaches the data network appliance of wherein the announcement message includes at least one user attribute, and wherein the registration request includes the at least one user attribute (col 3, line 54-56). *?*

As per claim 29, Gaucher teaches the data network appliance wherein the data network appliance determines whether the user is already registered to the data network appliance, and if so, does not transmit the registration request (col 6, line 8-15). *??*

As per claim 30, Gaucher teaches the data network appliance wherein the announcement message is validated prior to the registration module transmitting the registration request to the registration server (col 3, line 50-56).. *?? as here*

As per claim 31, Gaucher teaches the data network appliance, further comprising a memory, wherein the at least one user attribute is stored in the memory responsive to the registration module transmitting a corresponding registration request to the registration server (col 12, line 38-47). *??*

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As per claim 32, Gaucher teaches the data network appliance wherein the proximity receiver detects the announcement message including an associated user attribute, and wherein the registration module only transmits a registration request corresponding to the announcement message if the memory does not previously contain the associated user attribute (col 3, line 21-

30).

As per claim 33, Gaucher teaches the data network appliance further comprising a proximity transmitter operable to periodically transmit a ping message, wherein the announcement message is transmitted by the portable information device responsive to the portable information device receiving the ping message (col 8, line 33-41).

?? why wasn't this reference used for rejecting claim 60

As per claim 34, Gaucher teaches the data network appliance further comprising a proximity transmitter operable to transmit an acknowledgement message in response to the proximity receiver detecting the announcement message (col 7, line 48-57).

As per claim 36, Gaucher teaches the data network appliance wherein the proximity receiver and the proximity transmitter are radio frequency devices (col 7, line 48-61).

claim 21 states the opposite (as shown by 103)

As per claim 37, Gaucher teaches the data network appliance wherein the proximity receiver and the proximity transmitter operate according to the Bluetooth specification (col 7, line 53-65).

same contradiction

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As per claim 40, Gaucher teaches the data network appliance wherein the proximity receiver and the proximity transmitter respectively receive and transmit audible signals (col 6-7, line 64-5).

As per claim 41, Gaucher teaches the data network appliance of wherein the proximity receiver and the proximity transmitter respectively receive and transmit inaudible signals (col 6, line 34-40).

As per claim 42, Gaucher teaches the data network appliance, wherein the proximity receiver and the proximity transmitter respectively receive and transmit visible signals (col 7, line 6-12).

→ Contradiction

As per claim 43, Gaucher teaches the data network appliance, wherein the proximity receiver and the proximity transmitter respectively receive and transmit non-visible signals (col 6, line 34-40).

As per claim 44, Gaucher teaches the data network appliance wherein the registration request is in accordance with the Session Initiation Protocol (SIP) (col 3, line 51-56). ?

As per claim 45, Gaucher teaches the data network appliance wherein the registration request is in accordance with the H.323 Protocol (col 3, line 51-56). ?

As per claim 46, Gaucher teaches the data network appliance wherein the registration request is in accordance with the MEGACO protocol (col 3, line 51-56). ?

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As per claim 47, Gaucher teaches the data network appliance wherein the registration request is in accordance with the MGCP protocol (col 3, line 51-56).

As per claim 48, Gaucher teaches the data network appliance wherein the portable information device is a device selected from the group consisting of a personal digital assistant, a portable computer, a smart card, a portable phone, a two-way radio, an identification badge, and an electronic transaction card (col 6, line 34-40).

As per claim 73, Gaucher teaches at a data network appliance on a data network telephony system, a method for providing proximity registration of a user to a data network appliance, wherein a passive portable information device is associated with the user (col 3, line 21-26), the method comprising in combination:

reading a user attribute from a proximate passive portable information device, wherein the proximate passive portable information device is located within a proximity range from the data network appliance (col 3, line 21-26); and transmitting a registration request to a registration server, thereby registering the user of the proximate passive portable information device to the to data network appliance (col 3, line 51-56).

As per claim 74, Gaucher teaches the method wherein the step of reading the user attribute further includes accessing a database to obtain at least one registration attribute corresponding to the user attribute, and wherein the at least one registration attribute is used to format the registration request (col 3, line 51-56).

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As per claim 75, Gaucher teaches the method wherein the passive portable information device is a security badge (col 6, line 34-40).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 66-70 are rejected under 35 U.S.C. 102(e) as being anticipated by Bertsch (hereinafter “Bertsch”, USPN 5,938,757).

As per claim 66, Bertsch teaches a method for registering a user of a portable information device to a data network appliance, comprising in combination:

wirelessly transmitting a ping message from the data network appliance (col 4, line 28-36);

determining whether an announcement message has been detected from a portable information

device (col 4, line 43-49); and transmitting a registration request across a data network to a

registration server upon determining that the announcement message has been detected from the portable information device (col 4, line 43-49).

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As per claim 67, Bertsch teaches the method further comprising repeating the step of wirelessly transmitting the ping message from the data network appliance while the announcement message has not yet been detected (col 4, line 28-36). ?

As per claim 68, Bertsch teaches the method wherein the step of transmitting a registration request comprises: formatting the registration request using at least one user attribute included within the announcement message (col 4, line 32-36); transmitting the registration request across the data network to the registration server (col 4, line 28-36); receiving a confirmation message across the data network from the registration server (col 4, line 58-65); and wirelessly transmitting an acknowledgement message to the proximate portable information device (col 4, line 58-65).

As per claim 69, Bertsch teaches a method for providing proximity registration at a data network appliance, comprising in combination:

listening for an announcement message wirelessly transmitted by a proximate portable information device (col 4, line 43-48); and transmitting a registration request across a data network to a registration server upon detecting the announcement message (col 4, line 50-54). ?

As per claim 70, Bertsch teaches the method of Claim 69, wherein the step of transmitting a registration request comprises:

formatting the registration request using at least one user attribute included within the announcement message (col 4, line 32-36);

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transmitting the registration request across the data network to the registration server (col 4, line 4, line 50-54); receiving a confirmation message across the data network from the registration server (col 4, line 59-65); and wirelessly transmitting an acknowledgement message to the proximate to portable information device (col 4, line 59-65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 20-22, 26-27, 35, and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaucher (hereinafter "Gaucher", USPN 6,175,860) in view of Bertsch (hereinafter "Bertsch", USPN 5,938,757).

As per claim 20, Gaucher does not teaches the data network appliance wherein the proximity receiver is an infrared receiver. ? see col. 2, lines

Bertsch teaches the data network appliance wherein the proximity receiver is an infrared receiver (col 2, line 4-9).

Therefore, one of ordinary skill in the relevant art at the time the invention was made would have found it obvious to add Bertsch's infrared receiver to Gaucher's data network

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appliance because this enhance the usability of Gaucher's data network appliance since it would allow to receive infrared signal.

As per claim 21, Gaucher does not teach the data network appliance wherein the proximity receiver is a radio frequency receiver. ? see col 2, col 3

Bertsch teaches the data network appliance wherein the proximity receiver is a radio frequency receiver (col 2, line 4-9).

Therefore, one of ordinary skill in the relevant art at the time the invention was made would have found it obvious to add Bertsch's radio frequency receiver to Gaucher's data network appliance because this enhance the usability of Gaucher's data network appliance since it would allow to receive radio frequency signal.

As per claim 22, Gaucher does not teach the data network appliance wherein the proximity receiver operates according to the Bluetooth specification. ? see col 2

Bertsch teaches the data network appliance wherein the proximity receiver operates according to the Bluetooth specification (i.e. radio frequency) (col 2, line 4-9).

Therefore, one of ordinary skill in the relevant art at the time the invention was made would have found it obvious to add Bertsch's receiver to Gaucher's data network appliance because this enhance the usability of Gaucher's data network appliance.

As per claim 26, Gaucher does not teach the data network appliance further comprising: a video input interface operable to receive a video input signal from the user; a video output

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interface operable to transmit a video output signal to the user; and a video-over-data module operable to convert the video input signal into a digital video transmit stream, and wherein the video-over-data module is operable to convert a digital video receive stream into the video output signal.

Bertsch teaches the data network appliance further comprising:

a video input interface operable to receive a video input signal from the user; a video output interface operable to transmit a video output signal to the user ; and a video-over-data module operable to convert the video input signal into a digital video transmit stream, and wherein the video-over-data module is operable to convert a digital video receive stream into the video output signal (col 5, line 45-54).

Therefore, one of ordinary skill in the relevant art at the time the invention was made would have found it obvious to add Bertsch's video input interface and video-over-data module to Gaucher's data network appliance because this expands the usability of Gaucher's data network appliance.

As per claim 27, Gaucher does not teach the data network appliance wherein the video-over-data module is integral with the voice-over-data module, and wherein the digital audio transmit stream and the digital video transmit stream compose a digital AN transmit stream.

Bertsch teaches the data network appliance wherein the video-over-data module is integral with the voice-over-data module, and wherein the digital audio transmit stream and the digital video transmit stream compose a digital AN transmit stream (col 5, line 45-54).

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Therefore, one of ordinary skill in the relevant art at the time the invention was made would have found it obvious to add Bertsch's video-over-data module to Gaucher's data network appliance because this expands the usability of Gaucher's data network appliance.

As per claim 35, Gaucher does not teach the data network appliance wherein the proximity transmitter additionally transmits an acknowledgement message in response to the proximity receiver detecting the announcement message. ???

Bertsch teaches the data network appliance wherein the proximity transmitter additionally transmits an acknowledgement message in response to the proximity receiver detecting the announcement message (col 4, line 59-67).

Therefore, one of ordinary skill in the relevant art at the time the invention was made would have found it obvious to add Bertsch's acknowledgement response means to Gaucher's data network appliance because this allows receiver to acknowledge the successfully registration of network device.

As per claim 38, Gaucher does not teach the data network appliance wherein the proximity receiver is a magnetic field device (col 3, line 43-50).

Bertsch teaches the data network appliance wherein the proximity receiver is a magnetic field device (col 2, line 51-59).

Therefore, one of ordinary skill in the relevant art at the time the invention was made would have found it obvious to add Bertsch's proximity receiver to Gaucher's data network appliance because this expands the usability of Gaucher's data network appliance.

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As per claim 39, Gaucher does not teach the data network appliance wherein the proximity receiver and the proximity transmitter are infrared devices operating according to the IRDA specification. ??

Bertsch teaches the data network appliance wherein the proximity receiver and the proximity transmitter are infrared devices operating according to the IRDA specification (col 2, line 4-9).

Therefore, one of ordinary skill in the relevant art at the time the invention was made would have found it obvious to add Bertsch's infrared devices to Gaucher's data network appliance because this expands the usability of Gaucher's data network appliance.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Luo et al, Wesolck et al, and Bruno et al are cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shaojun Wen whose telephone number is (703)305-4874. The examiner can normally be reached on Monday – Friday (8:30-5:30). If attempts to reach the

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examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703) 308-7562. The fax number for the organization where this application or proceeding is assigned (703) 746-3999 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Shaojun Wen


Patent Examiner

Technology Center 2100

November 17, 2002


MOUSTAFA M. MEKY
PRIMARY EXAMINER